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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/004,221	10/26/2001	Keiji Nakagawa	11519-003001	7882

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FISH & RICHARDSON P.C.
45 ROCKEFELLER PLAZA, SUITE 2800
NEW YORK, NY 10111

EXAMINER

LOPEZ, FRANK D

ART UNIT	PAPER NUMBER
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3745

DATE MAILED: 11/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/004,221

Applicant(s)

NAKAGAWA ET AL.

Examiner

F. Daniel Lopez

Art Unit

3745

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 October 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Drawings

The drawings are objected to because figure 7 must be separated into figures 7A (for the larger drawing) and 7B (for the smaller drawing showing details of the larger drawing). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Figures 7A and 7B should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

A substitute specification in proper idiomatic English and in compliance with 37 CFR 1.52(a) and (b) is required. The substitute specification filed must be accompanied by a statement that it contains no new matter. Note, for example, on page 3 line 27 "but" should be --by--.

Claim Rejections - 35 USC § 112

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors. For example, in claim 2 line 2-3 "a groove making said inner wall surface nearby a part" should be --said inner wall surface includes a groove formed near a part--.

Claims 1-4 and 7 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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In claim 1 line marked 13 "but" makes no sense, suggest --by--replace it. In claim 1 line marked 14 "inner wall surface of said communicating hole" should be --inner wall surface of said through hole--(see page 14 line 24-26).

In claim 7 line 2 "said inner wall surface" has no antecedent basis.

Claims 2-4 are indefinite, since they depend from claim 1.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 10, 11 and 13 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Applicant's admitted prior art (see below). Note that the burr (as shown in the detail) is near an inner wall surface of the communicating hole, and near an inner wall surface of the through hole.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

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Claims 5-7, 12, 14 and 15 are rejected under 35 U.S.C. § 103 as being unpatentable over Applicant's admitted prior art in view of Injection Moulding Design. Applicant's admitted prior art discloses a master cylinder including a resin piston, method of making the resin piston and die for molding the resin piston, wherein the piston comprises a concavity (31) communicating with a through hole (32) by a communicating hole (33), wherein the piston is injected molded by first and second dies (11, 12) each including a corresponding core (15), with the through hole formed by the corresponding cores; and the concavity and communication hole is formed by a concavity core (13) abutting a flat surface of the corresponding cores (see detail of fig 7); wherein a groove forming an inner wall surface of the through hole, near the communication hole, has a flat surface; but does not disclose that the concavity core is inserted into an impact hole in the corresponding cores.

Injection Moulding Design teaches, for a piece formed by injection molding, using two dies and a core (fig 9.6b), that a tip of the core is inserted into an impact hole of the dies, for the purpose of preventing the core from damage (page 237 paragraph 3).

Since Applicant's admitted prior art and Injection Moulding Design are both from the same field of endeavor, the purpose disclosed by Injection Moulding Design would have been recognized in the pertinent art of Applicant's admitted prior art. It would have been obvious at the time the invention was made to one having ordinary skill in the art to insert a tip the concavity core of Applicant's admitted prior art into an impact hole in the corresponding cores, as taught by Injection Moulding Design, for the purpose of preventing the core from damage.

Claim 8 is rejected under 35 U.S.C. § 103 as being unpatentable over Applicant's admitted prior art in view of Injection Moulding Design, as applied to claim above, and further in view of Japan 2-28134, and claim 3 is rejected under 35 U.S.C. § 103 as being unpatentable over Applicant's admitted prior art in view of Japan 2-28134. Applicant's admitted prior art and the modified applicant's admitted prior art discloses all of the elements of claims 3 and 8, respectively, but does not disclose that the width of

the groove is narrower than that of the through-hole and wider than a diameter of a stop pin.

Japan 2-28134 teaches, for a master cylinder resin piston including a communicating hole (24) communicating with a through hole (15), and a groove (lower section of through-hole, see fig 5) forming an inner wall surface of the through hole, near the communication hole, has a flat surface (15c); that the width of the groove is narrower than that of the through-hole (i.e. upper part of the through-hole) and wider than a diameter (23) of the stop pin (22).

Since the through-holes of Applicant's admitted prior art and Japan 2-28134 are functionally equivalent in the piston art; it would have been obvious at the time the invention was made to one having ordinary skill in the art to form the width of the groove of Applicant's admitted prior art narrower than that of the through-hole and wider than a diameter of the stop pin, as taught by Japan 2-28134, , as a matter of engineering expediency.

Claim 9 is rejected under 35 U.S.C. § 103 as being unpatentable over Applicant's admitted prior art in view of Injection Moulding Design, as applied to claim above, and further in view of German 3932248, and claim 4 is rejected under 35 U.S.C. § 103 as being unpatentable over Applicant's admitted prior art in view of German 3932248.

Applicant's admitted prior art and the modified applicant's admitted prior art discloses all of the elements of claims 4 and 9, respectively, but does not disclose that the through-hole includes a projecting part for preventing a stopper pin from touching an inner wall surface near a part communicating with the communicating hole.

German 3932248 teaches, for a master cylinder piston including a concavity (42) communicating with a through hole (34) by a communicating hole (48); that the through-hole includes a projecting part (upper part of right side of piston 12, in fig 2) for preventing a stopper pin (38) from touching an inner wall surface near a part communicating with the communicating hole.

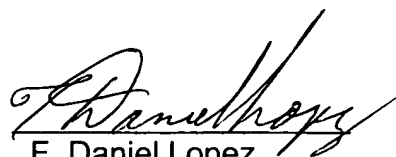
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Since Applicant's admitted prior art and German 3932248 are both from the same field of endeavor, the purpose disclosed by German 3932248 would have been recognized in the pertinent art of Applicant's admitted prior art. It would have been obvious at the time the invention was made to one having ordinary skill in the art to make the through-hole of Applicant's admitted prior art with a projecting part, as taught by German 3932248, for the purpose of preventing a stopper pin from touching an inner wall surface near a part communicating with the communicating hole

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dan Lopez whose telephone number is (703) 308-0008. The examiner can normally be reached on Monday-Thursday from 6:30 AM -4:00 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ed Look, can be reached on (703) 308-1044. The fax number for this group is (703) 872-9302. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0861.



F. Daniel Lopez
Primary Examiner
Art Unit 3745
November 25, 2002